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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,183	01/16/2004	Hiroyuki Mifune	FS-F03225-01	5527

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MS. YUMI YERKS
2111 JEFFERSON DAVIS HIGHWAY
APARTMENT #412, NORTH
ARLINGTON, VA 22202

EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,183

Applicant(s)

MIFUNE, HIROYUKI

Examiner

Richard L Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. Claims 18-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. There is no antecedent basis for the term "the particle" in claim 18.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. § 102(a) and (e) as being anticipated by Yabuki et al. Yabuki et al. (see particularly paragraphs 11, 83-108, 110, 111, 115) disclose photothermographic elements comprising silver iodide grains with over 40% iodide. The grains are reduction sensitized during crystal growth or grain growth. Chemical sensitizing using chalcogen compounds is also disclosed as well as metal complexes. The addition of compounds that generate two electrons is also

disclosed.

3. Claims 1-17 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yamamoto '175, Oka et al. '925 or Oka et al. '288. The applied references have a common assignee with the instant application. Based upon the earlier effective U.S. filing dates of the references, they constitute prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. Yamamoto et al. (see particularly paragraphs 170-179), Oka et al. '925 (see particularly paragraphs 44, 45, 56, 65-76, 27-34) and Oka et al. '288 (see particularly paragraphs 20-24, 27, 40, 41, 67-70, 209-218, 236-243, 642-649, 750-765) disclose photothermographic elements comprising silver iodide grains with over 40% iodide which are reduction sensitized preferably during grain growth. Chemical sensitizing using chalcogen and gold compounds, the incorporation of metal compounds or complexes and the use of compounds that release electrons are also disclosed.

4. Claims 1-17 are rejected under 35 U.S.C. § 102(a) as being anticipated by Oka et al. '288. Oka et al. '288 (see particularly paragraphs 20-24, 41, 40, 67-70, 209-218, 219, 227,

236-243, 642-649, 750-765) discloses photothermographic elements comprising silver halide grains with over 40% iodide which are reduction sensitized preferably during grain formation. Oka et al. also discloses using chalcogen and gold sensitizers, metal or metal complexes and compounds that release electrons in their silver halide emulsions.

5. Clais et al. is cited of interest in the art as disclosing reduction sensitizing of silver halide grains. Fukui et al. '216, Nariuki et al. '926, Nariuki et al. '785, Nariuki et al. '499 and Goto et al. are cited of interest in the art as disclosing photothermographic elements containing silver halide grains with over 40% iodide which may be chemically sensitized after grain formation. Mifune '457 is cited of interest in the art as disclosing the sulfur and gold chemical sensitizing of silver iodide grains for photothermographic elements. British Patent 1422057, Siga et al., Uytterhoven et al. and Dankosh et al. are cited of interest in the art as disclosing photothermographic elements containing silver halide grains with over 40% iodide.

6. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

Serial No. 10/758,183

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RLSchilling:cdc

June 15, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1100. 1752

